



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
P.O. BOX 1450
ALEXANDRIA, VA 22313-1450
www.uspto.gov

Paper No.

LAHIVE & COCKFIELD, LLP
FLOOR 30, SUITE 3000
ONE POST OFFICE SQUARE
BOSTON MA 02109

COPY MAILED
SEP 15 2008
OFFICE OF PETITIONS

In re Application of :
Takeshi Konno et al. :
Application No. 10/677,075 : DECISION ON TWO PETITIONS
Filed: September 30, 2003 : PURSUANT TO 37 C.F.R.
Attorney Docket No. TOW-045RCE2 : §§ 1.59(B) AND 1.181(A)
Title: ELECTRIC KEY SYSTEM FOR :
MOTORCYCLE :
:

This is a decision on the petition pursuant to 37 C.F.R. § 1.181(a) to withdraw the holding of abandonment, filed on July 14, 2008. This is also a decision on the concurrently filed petition pursuant to 37 C.F.R. § 1.59(b), requesting the expungement of evidentiary documentation that was filed in support of the petition pursuant to 37 C.F.R. § 1.181(a).

The petition pursuant to 37 C.F.R. § 1.181(a) is **GRANTED**.

The petition pursuant to 37 C.F.R. § 1.59(b) is **GRANTED**.

BACKGROUND

The above-identified application became abandoned for failure to reply in a timely manner to the non-final Office action, mailed November 15, 2007, which set a shortened statutory period for reply of three months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on February 16, 2007.

RELEVANT PORTIONS OF THE C.F.R. AND MPEP

37 C.F.R. § 1.59(b) sets forth, *in toto*:

(b) An applicant may request that the Office expunge information, other than what is excluded by paragraph (a)(2) of this section, by filing a petition under this paragraph. Any petition to expunge information from an application must include the fee set forth in § 1.17(g) and establish to the satisfaction of the Director that the expungement of the information is appropriate in which case a notice granting the petition for expungement will be provided.

Section 711.03(c)(I)(A) of the MPEP sets forth, *in toto*:

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133).

To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner describing the system used for recording an Office action received at the correspondence address of record with the USPTO. The statement should establish that the docketing system is sufficiently reliable. It is expected that the record would include, but not be limited to, the application number, attorney docket number, the mail date of the Office action and the due date for the response.

Practitioner must state that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including any file jacket or the equivalent, and the application contents, indicates that the Office action was not received. A copy of the record(s) used by the practitioner where the non-received Office action would have been entered had it been received is required.

A copy of the practitioner's record(s) required to show non-receipt of the Office action should include the master docket for the firm. That is, if a three month period for reply was set in the nonreceived Office action, a copy of the master docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action. If no such

master docket exists, the practitioner should so state and provide other evidence such as, but not limited to, the following: the application file jacket; incoming mail log; calendar; reminder system; or the individual docket record for the application in question.

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 2d 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988).

ANALYSIS OF THE PETITION PURSUANT TO RULE 1.181(A)

With this petition, Petitioner has alleged that the mailing was not received.

Petitioner has included a statement describing the system used for recording an Office action received at the correspondence address of record with the USPTO and establishing that the docketing system is sufficiently reliable. Petitioner has further stated that the Office action was not received at the correspondence address of record, and that a search of the practitioner's record(s), including the file jacket¹ indicates that the Office action was not received. Petitioner has provided a copy of the records used by the practitioner where the non-received Office action would have been entered had it been received is required, along with the master docket for the firm.

Moreover, the undersigned has reviewed the electronic file that is associated with this application, and it is noted that the non-final Office action of November 15, 2007 was returned to the Office as "not deliverable as addressed."

¹The Office is construing this submission to contain a statement establishing that a search of the application contents was conducted, and this search indicates that the Office action was not received. If this is not a proper interpretation of Petitioner's submission, Petitioner must notify the Office.

Considering the facts and circumstances of the delay at issue, as set forth on petition, it is concluded that Petitioner has met his burden of establishing that the Office communication was not received.

Accordingly, the petition under 37 C.F.R. §1.181(a) is GRANTED. The holding of abandonment is WITHDRAWN.

ANALYSIS OF THE PETITION PURSUANT TO RULE 1.59(B)

In order to support his assertion of non-receipt of the non-final Office action of November 15, 2007, Petitioner has included a copy of his firm's docket report and a copy of his firm's master docket. Petitioner has requested that each of these items be expunged from the file that is associated with this application.

The matter Petitioner wishes to have expunged does not form part of the original disclosure. The \$200 petition fee will be charged to Petitioner's Deposit Account in due course, as authorized in the petition.² Petitioner has established to the satisfaction of the Director that the expungement of this information is appropriate.

As such, the electronic document that contains these 110 pages has been closed in the Office's Image File Wrapper software viewing program. The paper documents will not be removed from the physical file however, as the Office does not remove papers from paper files which have been scanned.

CONCLUSION

The Technology Center will be notified of this decision. The Technology Center's support staff will re-mail the non-final Office action of November 15, 2007, and will set a new period for response.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the withdrawal of the holding of abandonment has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that

² Petitioner has asserted that he is of the belief that no fee is due, however it is noted that the Rule explicitly sets forth the requirement of the submission of the appropriate fee.

change of status must be effected - the Office of Petitions cannot effectuate a change of status.

Telephone inquiries regarding this decision should be directed to the undersigned at (571) 272-3225.³ All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.

/Paul Shanoski/
Paul Shanoski
Senior Attorney
Office of Petitions

³ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for any of Petitioner's further action(s).